

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

First Named Inventor: LEAH, ROBERT

Art Unit: To be assigned

Intl. Appln. No.: PCT/GB2005/000355

Examiner: To be assigned

Intl. Filing Date: 2 February 2005

U.S. Application No.: 10/588,897

Confirmation No.: 4108

For: A METHOD AND APPARATUS FOR OPERATING A SOLID-OXIDE FUEL
CELL STACK WITH A MIXED IONIC/ELECTRONIC CONDUCTING
ELECTROLYTE

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REQUEST FOR RECONSIDERATION OF DECISION
ON PETITION UNDER 37 C.F.R. § 1.181

OFFICE OF PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Decision on Petition Under
37 C.F.R. § 1.181, dated January 30, 2009.

The Decision held this application abandoned for failure to file a proper
Declaration and for failure to file a proper response to Form PCT/DO/EO/916
(Notification of Defective Response), mailed to Applicants on 30 October 2008. In
particular, the Decision held that Applicants' Declaration filed on 14 October 2008 was
non-compliant because it contained non-initialed alterations in some of the inventors'
post office addresses, and further that Supplemental Application Data Sheet filed on 24
November 2008 was not a valid response to Form 916.

It is noted initially, that Applicants at all times endeavored in good faith to comply
with the specific requirements made by the Office, as they were best understood.

Applicants timely furnished an executed Declaration after receiving, on 12 August 2008, a Notification of Missing Requirements Under 35 U.S.C. § 371.

On 30 October 2008, the Office notified Applicants, via Form 916, that the executed Declaration did not comply with 37 C.F.R. § 1.497(a) and (b) in that it:

“... is defective in that the address of the first three inventors has been scratched through and are hand written. **These hand written addresses are illegible and hard to read.** Please resubmit oath with **clear and legible address of all inventors.**” (Emphasis added.)

As Form 916 was best understood, the Office deemed Applicants' Declaration to be non-compliant because the addresses of the first three inventors had been scratched through and were hand written and, as such, these addresses were illegible and hard to read. There was no mention of non-initialed alterations as a reason for non-compliance. It was therefore understood that the Office was simply seeking clear and legible addresses for all inventors.

Applicants replied to Form 916 in good faith by submitting a Supplemental Application Data Sheet, which was believed to be a valid form of response under 37 C.F.R. §§ 1.497(c) and 1.67 to provide inventor address information. As the address information in the Supplemental Application Data Sheet was clear and legible, Applicants believed that the Supplemental Application Data Sheet fully satisfied Form 916.

Although Applicants had endeavored in good faith to comply with the Office's requirements, and had not sought relief under 37 C.F.R. § 1.181, their response to Form 916 was nevertheless treated as a Petition, and the application was held abandoned without Applicants having been given the opportunity to address the issue of non-initialed alterations, which was raised for the first time in the Decision.

A new Declaration has been requested of Applicants and will be filed shortly as a supplement to this Request for Reconsideration.

In view of Applicants' good faith efforts to comply with the Office's requirements, and further in view of the fact that the issue of non-initialed alterations was not specifically raised prior to issuance of the Decision on Petition, Applicants respectfully request reconsideration of the Decision and that the Office kindly accept the newly executed Declaration (which we will file shortly) so that this application may be reinstated for the U.S. National Stage and accorded a 35 U.S.C. § 371 date.

Applicants believe that there are no fees due in connection with the filing of this paper. However, the Commissioner is hereby authorized to charge Deposit Account No. 50-1165 (XA-10629) any fees that may be required by this paper, and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this paper and has not been separately requested, such extension is hereby requested.

Respectfully submitted,

Date: March 30, 2009

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